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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

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CHOI, FRANK I	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/802,425
Filing Date: March 09, 2001
Appellant(s): RHOADES, DEAN

William Thomas Babbitt
For Appellant

EXAMINER'S ANSWER

This is in response to the Supplemental Amended Replacement Appeal Brief (herein after "appeal brief") filed 3/30/2006 appealing from the Office action mailed 12/10/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejection of claims 1-3,21-23 under 35 U.S.C. 112, second paragraph, as being indefinite. The withdrawal herein does not constitute an admission of any of the Appellant's argument with respect to said rejection.

The rejection of claims 1-3, 5,7, 21,22 under 35 USC 103 as obvious over Imamura et al. (US Pat. 4,284,533). The withdrawal herein does not constitute an admission of any of the Appellant's arguments with respect to said rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,290,976	Messenger	9-2001
6,294,179	Lee et al.	9-2001
3,092,111	Saperstein et al.	6-1963
4,957,747	Stiefel	9-1990
2002/00090385	Fox et al.	7-2002
5,607,980	McAtee et al.	3-1997
5,756,081	Wdowik	5-1998
3,852,417	McLaughlin	12-1974

The American Heritage Dictionary of the English Language (4th Ed. 2000)[online],"moisturizer" [retrieved on 7/22/2003]. Retrieved from the internet <URL:http://www.bartleby.com/61/4/M0370450.html>.

Merriam-Webster's Collegiate Dictionary (10th Ed. 1998), p.749.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-3,21-23 contain the limitation "a base comprising at least about twenty three percent by weight a moisturizer". Claims 5,7 contain the limitation "a plurality of particles of corundum suspended in the base having an average particle size from 34 to 124 microns" and "wherein the plurality of particles of corundum are at least thirty five percent by weight of the composition". Claim 23 contains the limitation "wherein the plurality of abrasive particles are at least thirty five percent by weight of the composition". The Specification and claims as originally filed did not specifically disclose a base containing "at least twenty three percent by weight of a moisturizer", an average particle size of "124 microns" or "at least thirty five percent by weight of the composition" of corundum or abrasive particles. Further, the disclosure does not provide a written description as originally filed which would have reasonably conveyed to one of ordinary skill in the art that the Appellant's had possession of the same.

The following is summary table of the originally filed specification and claim disclosure relevant hereto:

Present Claim features that lack descriptive support	Original disclosure
"a base comprising at least about twenty three percent by weight a moisturizer" (claims 1-3 and 21-23) Claim Interpretation: the base is a component, which has, based on the weight of the base, at	Original claims – no % disclosure for moisturizer Specification paragraph 0014 – moisturizer is the "principal component."

least about 23 wt% moisturizer. Note the difference in language in claim 23, which recites "by weight of the composition" when referring to weight feature based on the composition weight. Difference in claim language indicates that the percentage in the quoted claim text is an internal percentage based on the base, not the overall weight of the composition.	Specification paragraph 0014 – no % disclosure. Moisturizers include substances that "tend to reduce water loss by creating a barrier," including petrolatum, mineral oil, lanolin and silicone derivatives. Glycerin, propylene glycol, alpha hydroxy acids, urea and lactic acid are also disclosed as moisturizers. Specification paragraph 0016 – 20 to 70% by weight aloe gel. No indication as to how much aloe is in the gel. Specification paragraph 0017 – 5 to 100 grams of corundum per ounce of cream. There is no indication as to what is in the cream or that the cream contains a moisturizer. Specification paragraph 0019, first 3 lines – 14 grams of corundum per ounce of cream moisturizer. Again, no disclosure of % of moisturizer in the cream. Specification, paragraph 0019, page 5, Table – multiple ingredients that could be moisturizers, i.e. "tend to reduce water loss by creating a barrier." Caprylic/Capric Triglycerides are hydrophobic fatty substances that would create a barrier. See McAtee et al., Column 17, lines 65-68, Column 18, lines 3, 8,9, Column 19, lines 3) (listing mineral oil, petrolatum and caprylic/capric tryclyceride under oils). This substance, when taken with appellant's admitted moisturizers of octyl palmitate, safflower oil, propylene glycol, panthenol and wheat germ oil (Appeal Brief (3/30/2006), pgs. 15, 21), would raise the moisturizer level to more than 38% of the composition. Specification, paragraph 0019, page 5, Table – the Appellant's basis for the claim language is the combined percentage of three or four alleged moisturizers in said Table (Appeal Brief (3/30/2006), pg. 15. However, the

	percentage in the Table is based on the weight of the composition in the Table not on the weight of a base contained in a composition as claimed. The Appellant uses the combined percentage of 22.9%, which is by weight of the composition, without adjusting for the difference between by weight of a composition and by weight of a base contained in the composition.
Corundum suspended in a base having an average particle size, wherein the upper limit is 124 microns (claims 5, 7)	Specification, paragraph 0012 –corundum having an average particle size of 34-556 microns, preferably about 42-198 microns. No disclosure of an upper limit of 124 microns.
Corundum or abrasive particles are at least thirty five percent by weight of the composition (claims 5,7, 23). Claim interpretation: amount of corundum or abrasive particles can range from 35% up to but not including 100% of the claimed composition.	Specification paragraph 0016 – 20 to 70% by weight corundum. Amount of 35% not disclosed, upper limit of 70% disclosed. Specification paragraph 0017 – 5 to 100 grams of corundum per ounce of cream. No disclosure as to % corundum by weight of the cream. Specification paragraph 0019 – approximately 14 grams of corundum (aluminum oxide) per ounce of cream moisturizer disclosed to be equivalent to 35% by weight of the composition. No disclosure of the range of at least 35%.

For these reasons, the disclosure does not provide a written description as originally filed which would have reasonably conveyed to one of ordinary skill in the art that the Appellant's had possession of the same.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Messenger (US Pat. 6,290,976).

Messenger expressly discloses a preferred form of the invention that is a cream composition containing water (QS to 100%) (diluent), Corundum (40%) (abrasive) (120 FEPA (about 125 microns), stearic acid (6-8%) (emulsifier/emollient), mineral oil (56%) (emollient), cetyl alcohol (2-3%) (emulsifier emollient), glyceryl stearate SE (1-2%) (emulsifier/emollient), cocoa butter (1%) (emollient/fragrance), polysorbate 20 (emulsifier), titanium dioxide, Aloe Vera gel (less than 1%)(protectant/moisturizer), Vitamin E and preservatives which is applied to the facial tissue falling within the scope of the Appellant's claims (Column 3, lines 34-51, Column 4, lines 34-64, Example 1, claims 1-7). About 120 FEPA (about 125 microns) is sufficiently specific to the claimed 124 microns such that one of ordinary skill in the art would immediately envisage 124 microns as being about 125 microns.

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same

exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lee et al. (US Pat. 6,294,179)

Lee et al. expressly discloses an exfoliant composition containing sodium lauryl ether (3EO) sulphate (11.7.0%) (surfactant), sodium coco amido propyl betaine (1.80%) (surfactant), calcite (DURACAL® 130) (size range of 50-400 microns and mean particle size of 130 microns) (10.00%), perfume (1.00%), hectorite (1.35%), NaCl (0.45%), preservative (0.63%), opacifier (0.40%) and water (to 100%) which has a viscosity 6100 mPas $10s^{-1}$ due to the addition of the NaCl to the hectorite sol and is applied to the skin and exfoliant compositions containing sodium lauryl ether (3EO) sulphate (11.70%), sodium coco amido propyl betaine (1.80%), calcite (DURACAL® 130) (size range of 50-400 microns and mean particle size of 130 microns) (10.00%), perfume (1.00%), hectorite (1.35%), xanthan gum (0.2%), NaCl (1.30% or 1.50%), preservative (0.63%), opacifier (0.40%) and water (to 100%) having a viscosity of Pa · s at 10 Hz of 5.0 and 6.6, respectively falling within the scope of Appellant's claims (Column 2, lines 33-35, Column 3, lines 54,55,59,60, Column 4, Column 5, Column 6, lines 1-20). Said compositions have the viscosity of gels, hectorite is a swelling clay which is thickened by the NaCl suspend the exfoliant calcite particles and xanthan gum facilitates the suspension of the calcite particles (Column 2, 55-59, Column 3, lines 12-40)

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same

exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3, 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saperstein et al. (US Pat. 3,092,111).

Saperstein et al. expressly discloses three abrasive compositions, Examples 5, 6, 7, respectively, which are used to treat acne, containing by weight of the composition, 56.5%, 43.3% and 31.0%, respectively, of a base, 1.0% hexachlorophene, 5.3%, 4.3% and 3.3%, respectively, of bentonite, and 37.1%, 51.4% and 64.7%, respectively, of the abrasive of Ex. 1, 2 and 3, respectively, for a total of 100% (Column 7, lines 41-72) falling within the scope of the Appellant's claims. The base contains by weight of the base, sodium lauryl sulfate (12.0%) (surfactant), sodium laurate (3.5%) (soap), sodium myristate (3.5%) (soap), lanolin (0.5%) (emollient), polyethylene glycol (10.1%) (emollient), glycerine (2.8%) (emollient) and water (60.6%) for a total of 100% (Column 7, lines 1-35). The abrasives of examples 1, 2, 3 contain aluminum oxide having the following size ranges in microns by weight of said examples, 1.5%, 1.2% and 1.0%, respectively, of 125-149 microns, 6.7%, 6.2%, 5.9%, respectively, of 149-177 microns, 25.0%, 23.7%, 22.8%, respectively, of 177-250 microns, and 45.7%, 45.9% and 45.8%, respectively, of 250-420 microns (Column 6, lines 43-70).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3, 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stiefel (US Pat. 4,957,747).

Stiefel expressly discloses compositions by weight of the composition, 38.020%, 52.1057%, respectively, of aluminum oxide (Bento Grit Fine), 4.2360 and 3.2812%, respectively of PEG 75 (emollient), 1.6944% and 1,3125%, respectively, of Glyceryl stearate/PEG 100 stearate (emollient), 1.1296% and 0.8750%, respectively, of dimethicone, 0.5648% and 0.4375%, respectively, of octyl hydroxystearate (emollient), 4.8400% and 3.0043%, respectively, of bentonite (suspending agent which facilitates maintenance of aluminum oxide suspension), stearic acid, myristic acid, sodium hydroxide, 1.9203% and 1.3125%, respectively, of a humectant (glycerine), foam builder (diethyl lauramide), antioxidant/preservative and 32.0158% and 24.4052%, respectively, of water, which are applied to the skin and a method of improving the firmness and tone of aged skin which comprises repeatedly applying to the aged skin a fluid topical composition containing a suspension of fine particles of a non-absorbable aluminum oxide abrasive in a topically acceptable aqueous base, where the topical composition is a paste containing from about 35% to about 65% by weight of the composition of aluminum oxide particles 80% or more of which have a particle size ranging from 170-600 microns with 40-50% falling in the 250-420 micron rang and the aqueous base contains by weight of the composition about 20 to about 50% water, about 5 % to about 10% of sodium cocoisethionate, about 5% to about 10% of at least one emollient selected from PEG, fatty acid esters of PEG, dimethicone and alkyl sters of fatty acid and the suspending agent bentonite, falling within the scope of the Appellant's claims (Column 2, Examples 1,2, Claims 1,7).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US 2002/0090385).

Fox et al. discloses a portable, inexpensive, easy to use microdermabrasion composition which is applied to the skin containing abrasive coated crystals of aluminum oxide and/or magnesium oxide having particles sizes of about 40-2000 microns, preferably about 100-1200 microns and most preferably about 600-800 microns, in a cream carrier where the coated crystal to carrier ratio is within the range of about 2%-99%, preferably about 50% (1:2) and that the composition can additionally Vitamin C, Vitamin E and moisturizers as desired to be used in the cosmetic (Paragraphs 0005,0012,0013, 0024-0028, Claims 1-7).

The prior art discloses a microdermabrasion composition containing aluminum oxide in a cream with other ingredients. The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a composition in the form of a cream having corundum suspended in the base with an average particle size of 34 to 124 microns. However, the prior art amply suggests the same as the prior art discloses the incorporation of aluminum oxide crystals in a cream and particles sizes of about 40 and about 100 microns and additionally adding other substances such as Vitamin C, Vitamin E and moisturizers. Further, the prior art also discloses that magnesium oxide can also be combined with the aluminum oxide to provide abrasion of the skin. As such, the claimed invention would have been well within the skill of and

one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the cream carrier would hold the aluminum oxide crystals, that other substances which are known to be used in cosmetics, such as vitamins and moisturizers, could be added as desired, that the combination of magnesium oxide with the aluminum oxide would also be effective to abrade the skin, that the composition would be portable, inexpensive and easy to use, and that the size of the particles could be varied depending on the desired abrasiveness of the composition.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

Claims 1-3, 21,22 are rejected under 35 U.S.C. 103(a) as obvious over McAtee et al. (US Pat. 5,607,980).

McAtee et al. discloses a composition which is useful for application to human skin for conditioning, desquamating, treating dry skin and in cleansing embodiments for cleansing the skin without over-drying or irritating the skin (Column 3, lines 44-49). It is taught that the composition can be in the form of a cream (Column 4, lines 3-6). It is disclosed that the composition can contain about 20% of one or more humectants or moisturizers, such as lactic acid, Aloe Vera gel, glycerol, propylene glycol and from about 20% of insoluble particles which act to enhance the cleansing effect of the composition, having a particle size of about 75 up to about 400 microns and which include aluminum oxide (Column 13, lines 40-68, Column 14, Column 15, lines 1-55).

The prior art discloses a composition which can be in the form of a cream and contain humetants or moisturizers and aluminum oxide particles having a size of about 75 up to about 400 microns. The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a composition comprising at least twenty percent by weight moisturizer and a plurality of abrasive particles in the range of 50 microns to 556 microns or a cream having corundum having particles sizes from 34 to 124 microns. However, the prior art amply suggests the same as it is known to use humectants or moisturizers in an amount of about 20% in topical compositions for conditioning, desquamating, treating dry skin and cleansing the skin, to formulate the same in a cream and to use insoluble particles having sizes with the claimed ranges to enhance the cleansing effect. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation of formulating a skin cleanser which does not over-dry the skin.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wdowik (US Pat. 5,756,081).

Wdowik expressly discloses a shaving cream containing potassium stearate, sodium stearate, lauric acid diethanolamide (1.60%), mineral oil (17%), stearic acid (0.13%), coconut fatty acid (0.68%), glycerine (3.2%), PVP (0.12%), perfume, water (57.58%), propellant, and particulate additive (3%) (about 75 microns in size) falling within the scope of applicant's claims (Column 6, lines 3-20).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978).

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin (US Pat. 3,852,417) in view of Wdowik (5,756,081).

McLaughlin discloses a shaving cream containing a water-soluble soap, a liquid oil material such as mineral oil, safflower oil, isopropyl myristate, and isopropyl palmitate, etc. and mixtures thereof in the range of from 12 to about 25%, with mineral oil being preferred, to provide a lubricating or emollient effect (Column 2, lines 18-68, Column 3, lines 1-25). It is disclosed that fatty acid diethanolamides, such as lauric acid diethanolamide, are supplemental emollients which supplement the emollient action of said liquid oil and help to achieve the desired beneficial lubricating properties (Column 3, lines 26-53, Columns 5-7, Examples 1-6). It is disclosed that if a highly unsaturated triglyceride oil such as safflower oil is used the composition also preferably contains an antioxidant compound to prevent rancidity (Column 3, lines 12-14). It is disclosed that it is advantageous to include up to 8% by weight of glycerine or polygycol humectant in the shaving cream composition (Column 4, lines 27-30). Various embodiments are disclosed containing mixtures of mineral oil and glycerine (including one which combined equals a total of 23.2% of the composition) or propylene glycol (Column 5, lines 10-68, Column 6, lines 31-68, Column 7, lines 1-25, Examples 1, 3-7, claims 1-8). It is disclosed that use of shaving cream of example 1 resulted in skin which was softened and moisturized (Column 5, lines 65-68).

Wdowik discloses the incorporation of insoluble particulate additives such as aluminum oxide, titanium oxide, calcium phosphate, calcium carbonate, etc., including mixtures thereof, having a practical range of about 10 to 500 microns and preferred range of 50 to 200 microns into shaving creams such as that disclosed in US Pat. 3,852,417 to McLaughlin to reduce undesired nicks and cuts, scrub the skin, and improve post-shave smoothness and cleanliness of the skin (Column 3, lines 1-40, Column 4, lines 55-68, Columns 5, 6). It is disclosed that while 0.1% to 20% by weight of the insoluble particulate additives is adequate, greater than 20% by weight can be included and in thick pastes, solids and gels even as high as 90% or greater may be used to practice the invention (Column 3, lines 45-55). It is disclosed that the solid particulate additives also work to remove dirt, oils, stains and dead skin cells form the skin surface thereby improving the smoothness and cleanliness of post-shave skin surfaces (Column 3, lines 62-68, Column 4, lines 1-55). An embodiment is disclosed in the form of a shaving cream containing potassium stearate, sodium stearate, lauric acid diethanolamide (1.60%), mineral oil (17%), stearic acid (0.13%), coconut fatty acid (0.68%), glycerine (3.2%), PVP (0.12%), perfume, water (57.58%), propellant, particulate additive (3%) about 75 microns (Column 6, lines 3-20).

The prior art discloses a shaving cream containing humectants and moisturizers. The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the use of aluminum oxide or amount of abrasive particles in the amount of 35% or more. However, the prior art amply suggests the same as it taught that the prior art compositions can contain more than 20% of said particles, including up to 90% and greater, and aluminum oxide is disclosed as a suitable insoluble particulate additive. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the

prior art as above with the expectation that the amounts of abrasive particles could be varied including to with the scope of the claimed amounts depending on the desired abrasiveness or scrubbing action desired and that various abrasive particles could be interchangeable used including aluminum oxide to reduce undesired nicks and cuts and improve post-shave skin smoothness.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

(10) Response to Argument

As a preliminary matter, the Appellant provides an overview of the prior art. The examiner acknowledges the same but makes no admission as to the validity of any of the statements made in the overview. The examiner asserts that prior art disclose what they disclose and any summary thereof by the Appellant and conclusions as to what they do or do not disclose cannot be contrary to the subject matter disclosed therein.

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Appellant does not cite to anywhere in the Specification which includes about 23% of a single agent which is a moisturizer. Notwithstanding the same, the examiner agrees with the Appellant's argument that a moisturizer can include a combination of ingredients. The Appellant argues that there is no evidence that water has moisturizing properties, however, this is not material to the written description rejection and the Appellant's argument will be addressed in the prior art rejections below. In order to arrive at the phrase "at least about twenty three percent

by weight a moisturizer", the Appellant selects three ingredients, Safflower Oil (10%), Octyl Palmitate (10%) and Propylene Glycol (2.9%), from the example in paragraph 19 of the Specification which contains 27 ingredients, to arrive at an amount of 22.9% and then mentions that the composition also contains 1% of panthenol (Appeal Brief (3/30/2006), p. 15. The problem is that said percent weights in the example are based on the weight of the composition whereas the weight of the moisturizer in claim 1 is based on the weight of the base. The aluminum oxide particles in the example constitute 35% by weight of the example composition. As such, the base constitutes 65% of the example composition. Accordingly, the combined percent weight of the three ingredients based on the weight of the base is 35.23%. Since the disclosure cited by Appellant does not provide support for the minimum amount of about 23% based on the weight of the base, the Appellant has not shown possession of the claimed range of at least about 23%.

Further, of the three ingredients, only propylene glycol is specifically identified as a compound that may be included in a moisturizer (Specification, paragraph 14). The Appellant provides no evidence that the other compounds have the property of a moisturizer or that panthenol has humectant properties. The arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See In re Budnick, 190 USPQ 422 (CCPA 1976); In re Schulze, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); In re Cole, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). The Appellant has arbitrarily chosen three or four ingredients, of which only one ingredient is specifically recited in the Specification to be included in a moisturizer, in order to arrive at the amount of about 23% and range of at least about 23% by weight of the base of a moisturizer.

However, neither the amount nor the range was disclosed in the Specification and claims as originally filed. Similarly, with respect to the range of at least 35% of corundum or abrasive particles in claims 5 and 23, respectively, the Appellant has cited to the disclosed amount of 35% aluminum oxide in the example of paragraph 19 of the Specification as the basis for an open-ended limitation that was not disclosed in the Specification and claims as originally filed.

This is the type of overreaching that the written description requirement was designed to prevent. See Purdue Pharma L.P. v. Faulding Inc., 56 USPQ2d 1481, 1487 (CA FC 2000); See also In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) ("If n-propylamine had been used in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present specification. The trouble is that there is no such disclosure, easy though it is to imagine it."). Further, the range of at least about 23% by weight of the base of a moisturizer and the range of at least 35% by weight of the composition of the corundum or abrasive particles clearly encompasses embodiments which are outside the scope of 22.9%, about 23.9% if panthenol was included, or even 35.23%, relative to the combination of alleged moisturizers, and 35% of aluminum oxide. Further, said ranges also include embodiments which are outside the scope of the ranges disclosed in paragraphs 16 and 17 of the Specification cited to by the Appellant. Paragraph 16 discloses a range of 20-70% corundum and 20-70% of aloe gel. Paragraph 17 discloses a range of about 5-100 gm corundum per ounce of cream. As such, said claimed ranges lack written description support in the Specification and claims as originally filed. See In

re Wertheim, 191 USPQ 90,97 (CCPA 1976) (Wertheim I) (range of "at least 35%" read literally on embodiments outside of the ranges described in the application); PIN/NIP Inc. v. Platte Chemical Co., 64 USPQ2d 1344, 1352-1353 (CAFC 2002) (lack of written description for sequential administration where examples disclosed mixtures).

There does not appear to be any disclosure in the Specification that sets forth the average particle size of 124 microns and the Appellant offers no reason why 124 microns was chosen as opposed to some other number. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., In re Lukach, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); In re Smith, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads). See also Purdue Pharma L.P. v. Faulding Inc., 56 USPQ2d 1481, 1487 (CA FC 2000); In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

The Appellant's reliance on Wertheim I is misplaced. The Court in Wertheim I specifically stated that they were not creating a rule applicable to all description requirement cases involving ranges. The Appellant herein appears to have arbitrarily chosen a number in the sense that the Appellant could have also selected any number between 34 and 125 microns in an attempt to overcome the prior art. See In re Rodman, 106 USPQ 142, 144,145 (CCPA 1955). The Appellant quotes extensively from Wertheim I, however, Wertheim I also indicates that "where it is clear, for instance, that the broadly described range pertains to a different invention than the narrower (and subsumed) claimed range, then the broad range does not describe the narrower range." See Wertheim I at pg. 98. The Court concluded that "in the context of *this*

invention, in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of appellants' invention and would be led by the Swiss disclosure so to conclude as a part of appellants' invention." See Wertheim I at pg. 98. As such, the ruling in Wertheim I was based on the fact there was a specific embodiment of 36% and a disclosed range of 25% to 60% to support the claimed range of 35% to 60%.

The examiner is not asserting that merely because there is no express disclosure that the limitation of "124 microns" constitutes new matter. The Appellant amended claim 5 to recite an average micron size of less than 125 microns in an attempt to overcome the rejection of claim 5 over Saperstein et al (See Remarks (5/16/2003), pgs 5, 6). Claim 5 was subsequently amended to recite the range of 34-124 microns in response to a 35 USC 112, 1st paragraph rejection (See Remarks (11/20/2003), pg. 3). Claim 5 as originally filed recited a range of 34-556 microns. The Appellant's attempt to overcome the prior art by amending the claims to recite a range of less than 125 microns is essentially an assertion that said range is patentably distinct from the range of 34-556. Since the presently claimed range of 34-124 microns falls within the range of less than 125 microns, said assertion applies to the range of 34-124 microns. As such, since the Appellant has essentially asserted that the range of 34-124 microns is patentably distinct from the broader range of 34-556 microns, there is no need for the Patent Office to provide evidence that there is distinction in terms of operability or achievement of any desired result between the claimed lower limit and the broader limit as, if said assertion is valid, "it is clear . . . that the broad described range pertains to a different invention than the narrower (an subsumed) claimed

range". *Id.* As such, "the broader range does not describe the narrower range". *Id.* Contrary to the Appellant's arguments, In re Wertheim, 209 USPQ 554 (CCPA 1981) (Wertheim II) is directly on point. In Wertheim II, the Court disagreed with the Board's apparent determination that because the range of 35% to 60% was within the broad disclosure of the parent case said range in the continuation-in-part case did not constitute new matter. The Court held that said limitation did constituted new matter and was relevant because said limitation avoided the prior art. Wertheim II at pg. 565. It is immaterial that Wertheim II involved the issue of priority between related applications because the 35 USC 112, 1st paragraph analysis is the same regardless of whether one is deciding whether a later filed claim has support in a parent application or whether an amended claim has support in the specification and claims as originally filed.

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Messenger (US Pat. 6,290,976).

The Appellant argues that the 131 affidavit is sufficient to antedate the cited reference. A rule 131 affidavit cannot be used where the US Patent or US Patent Application claims the same invention. See MPEP 715 [R-1]. The term "same invention" includes an obvious variation. Claim 1 of the cited reference claims a facial skin cleansing and conditioning composition consisting essentially of a mild skin abrasive including corundum powder having a size of about 120 FEPA, an emulsifier including stearic acid, cetyl alcohol and glyceryl stearate SE and polysorbate 20, an emollient including mineral oil and cocoa butter, a protectant and moisturizer including aloe vera, a neutralizer including triethanolamine, a chelator including trisodium EDTA, a preservative including methyl paraben, propylparaben and diasolidinyl urea and a

diluent. Example 1 of the cited reference discloses the combination of said ingredients and amounts thereof, including 40% corundum and 56% mineral oil, which meet the Appellant's claim limitations of a base containing at least about 23% of moisturizer ingredients and at least 35% of corundum or abrasive particles. Since Example 1 reads on claim 1 of the cited reference, one of ordinary skill in the art would have been motivated to modify the limitations of claim 1 to recite the amounts disclosed in Example 1 with the expectation that the same would be effective as a facial skin cleansing and conditioning composition. Although the Examiner is relying on the disclosure in the specification of Messenger in order to modify claim 1 (See the Appellant's argument in Remarks (2/15/2005), Pg. 10), the Examiner believes that this is permissible in view of the ruling in Ex parte Standish, 10 USPQ2d 1454, 1457, 1458 (BdPatApp&Int 1988).

In Ex parte Standish, the patent claimed the claimed invention except rotation of the propellers in opposite directions and it was unclear whether the patent actually disclosed or suggested the same. *Id.* at pg. 1457. The Board applied another patent reference to make up the deficiency and held that it would have been obvious to modify the claims of the patent to include the missing feature in view of said other patent. *Id.* at pg. 1458. The Board concluded that in light the claims of the application defined the same patentable invention as claimed by the patent. *Id.* The Examiner sees no difference between using the reference's own specification to modify the claims and using another reference. In fact, the case herein is even stronger because the only difference between the claims of the reference and the claimed invention is that claims of the reference do not expressly disclose amounts falling within the scope of the claimed invention because the claims do not recite any specified amount and the reference expressly or inherently discloses a composition falling within the scope of the claimed invention. Since it would be

obvious to modify claim 1 of the reference to include said amounts, as indicated above, which amounts do fall within the scope of the claimed invention, claim 1 of Messenger claims the same invention as the claimed invention and the 131 affidavit is not applicable to antedate the reference.

The Appellant argues that a review of the Affidavit shows that there is at least 22.3 percent of components in the base that can be classified as moisturizers and that with respect to the amount of Abrasive particles, the Affidavit sets forth a composition including 50 percent particles (Appeal Brief (3/30/2006), pg. 21. However, said arguments appear to contradict the affiant's sworn statements. The affiant in the 131 affidavit stated as follows: "Exhibit A is a formulation of a creme base having moisturizer ingredients that are twenty percent by weight of the base. Exhibit B is a formulation of a composition with the creme base of Exhibit A and aluminum oxide with a particle size of 120. These documents demonstrate the practice of the invention . . . ." (Affidavit (filed 9/16/2004), paragraph 8). Further, the affiant does not identify which ingredients are moisturizer ingredients much less which of said ingredients add up to 20% (or 22.3% as indicated above) by weight of the cream base or indicate that Exhibits A and B support the claimed limitation of "at least 35%" of corundum or abrasive particles. The Appellant incorrectly identifies one of the ingredients as being "panethenol". The ingredient is actually "50% panthenol" and there is no indication what the other 50% constitutes (See Affidavit (filed 9/16/2004), Exhibit A). As such, the amount of panthenol is actually 0.15% by weight of the base. Also, the Specification does not specifically identify, except for propylene glycol, any of the six ingredients argued by the Appellant as adding up to 22.3% as being moisturizer ingredients and the Appellant provides no evidence that said ingredients have the

property of moisturizers. Furthermore, the composition in Exhibits A and B of the affidavit is different from example in paragraph 19 of the Specification. The Appellant add six ingredients in order to obtain an amount of 22.3% (actually 22.15% (due to the use of 50% panthenol)) by weight of the base, whereas, the Appellant used three ingredients in the example of paragraph 19 to arrive an amount of 22.9% by weight of the base (although, as indicated above, this was incorrect since the percent weights in the example were by weight of the composition not by weight of a base), and the aluminum oxide in Exhibit B of the affidavit is 50% by weight of the composition and has micron size of 120, whereas, the aluminum oxide in paragraph 19 of the Specification is 35% by weight of the composition and does not indicate a particle size. As such, in view of the statements made under oath by affiant and the differences between the composition in Exhibits A and B of the affidavit and the composition in paragraph 19 of Specification which was used by Appellant to arrive at ranges of at least about 23% and at least 35%, the 131 affidavit is directed to subject matter which is wholly outside the claimed invention. See In re Tancyzn, 136 USPQ 298, 301 (CCPA 1965).

Finally, a 131 affidavit, in addition to either showing possession of the whole invention or possession of something falling within the claim, in the sense that the claim as a whole reads on it, must show what the reference shows. See In re Tanczyn at 301. Example 1 of Messenger recites a composition which includes among other ingredients, 56% mineral oil (emollient), 40% corundum (abrasive), 2-3% cetyl alcohol (emollient), 1-2% glyceryl stearate SE (emollient), 1% Cocoa Butter (emollient) and less than 1% Aloe Vera gel (moisturizer). Claim 2 recites that the moisturizer comprises at least one of an emollient. As such, the emollients above read on the limitation "moisturizer". The base in the 131 affidavit does not disclose the combination of 40%

corundum, 56% mineral oil (or in fact any mineral oil), any of the other emollients, or Aloe Vera gel and requires a combination of ingredients to arrive an amount of 22.3% (actually 22.15% (due to the use of 50% panthenol)); whereas, the prior art discloses an amount of a single ingredient, mineral oil (56%) which is sufficient to fall within the scope of the claimed range of at least about 23% by weight of the base of a moisturizer. As such, the 131 affidavit does not show what the reference shows and is not sufficient to antedate the prior art reference.

The Appellant argues that the Patent Office also argues that the affidavit is not commensurate in scope to the extent the claimed invention shows conception and reduction prior to the effective date of Messenger. However, the Appellant's characterization of the Patent Office's argument does not appear to be accurate. The Examiner actually argued that the affidavit was not commensurate in scope to the extent the claimed invention is shown in Messenger in that the affidavit indicated 20% of a moisturizer, 50% of 120 micron aluminum oxide whereas Messenger discloses 40% of about 125 micron corundum and 56% mineral oil and citing to In re Wakefield, 164 USPQ 636 (CCPA 1970) (See Advisory Action (4/15/2005), pg. 2). The Appellant does not address this argument other than to indicate that absent Messenger claiming the same invention, the reference is not available as prior art. Although in said Advisory Action, the Examiner conceded that Messenger does not claim the same invention, the Examiner did not have the benefit of the ruling in Ex parte Standish cited above. The Examiner, however, had previously argued that Messenger did claim the same invention (Office Action (3/11/2004), Pg. 6; Office Action (12/10/2004), pg. 6). As such, the argument above reinstates the argument made in said prior Office Actions. As such, contrary to the Appellant's argument, as indicated above, Messenger does claim the same invention.

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lee et al. (US Pat. 6,294,179).

A. Claims 1, 2, 22

Contrary to the Appellant's arguments, Lee et al. does expressly disclose an amount of a moisturizer that falls within the scope of the range of at least about 23% by weight of the base of a moisturizer. The Specification does not exclude water from being included as a component of a moisturizer. One definition of "moisturizer" is cosmetic lotion or cream applied to the skin to counter dryness. The American Heritage Dictionary of the English Language (4th Ed. 2000)[online],"moisturizer" [retrieved on 7/22/2003]. Retrieved from the internet <URL:http://www.bartleby.com/61/4/M0370450.html>. Another definition of "moisturizer" encompasses a substance that adds moisture to something. See Merriam-Webster's Collegiate Dictionary (10th Ed. 1998), pg. 749 (moisturize- to add moisture to; moisturizer). McAttee et al. discloses that "the exact level of water will depend upon the form of the product and the desired moisture content". (McAtee et al., Column 9, lines 34-40). The Appellant has admitted that water is moisture (Remarks (9/16/2004), pg. 10). Claim 2 of the claimed invention recites that a moisturizer comprises at least one of a liquid, a gel and an emollient. The Specification indicates that aloe gel is a moisturizer (Specification, paragraph 0016). As such, the limitation "moisturizer" can comprise a combination of ingredients of which water can be a component thereof. The carrier in Lee et al. contains a mixture of water, surfactants, hectorite or hectorite and xanthan gum, NaCl which causes the hectorite to swell and provide sufficient viscosity to suspend the calcite particles contained in the composition, and other ingredients, has the viscosity of a gel and is applied to the skin. As such, since the carrier contains swelled hectorite

and would add moisture to the skin, the carrier constitutes a moisturizer. Since the amount of said carrier is greater than about 23%, the prior art composition reads on the claimed invention.

The Appellant argues that water is outside the scope of moisturizer as defined in the Specification. However, the Specification does not clearly define moisturizer as excluding water or even being limited to substances that reduce water loss from the skin and/or draw moisture from the inner skin layers up into the outer skin layer. See Lear Siegler, Inc. v. Aeroquip Corporation et al., 221 USPQ 1025,1031 (CAFC 1984) (inventor may be own lexicographer, however, the place to do so is in the specification of the inventor's application); Merck & Co. v. Teva Pharmaceuticals USA Inc., 73 USPQ2d 1641, 1646 (CA FC 2005) (("The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim.").

Paragraph 14 of the Specification indicates that Appellant believes that moisturizers reduce water loss from the skin and draw moisture from inner skin layer up into the outer skin layer. If said language constitutes a definition that is reasonably clear, deliberate and precise, than propylene glycol, safflower oil and octyl palmitate are not moisturizers because the Specification does not describe safflower oil, octyl palmitate and propylene glycol as each having both barrier functions and drawing of water functions. Paragraph 14 further indicates that in one embodiment a moisturizer can include a substance that draws water from the skin. Paragraph 14 then indicates that the moisturizer may also include substances that tend to reduce water loss by creating a barrier. Based on this language, the use of ingredients that reduce water loss from the skin or ingredients that draw moisture from the inner skin layers into the outer skin layer appear to be optional. As such, the language in paragraph 14 is contradictory, and, thus, is

not sufficiently clear, deliberate and precise. Paragraph 14, further, does not exclude water as being part of the combination of ingredients. Paragraph 15 of the Specification indicates that the moisturizers may be in various form known in the art, including liquids, creams, gels, pastes and emollients and Claim 2 claims that the moisturizer comprises at least one of a liquid, a gel, and an emollient. As such, the limitation "moisturizer" can include a mixture of ingredients of which water can be one of the ingredients. As such, the composition in Lee et al. will moisturize the skin. Thus, regardless of whether water by itself would constitute a moisturizer, the Appellant's arguments do not establish that a moisturizer cannot include water as part of the moisturizer. Therefore, the prior art composition appears to fall within the scope of the claimed invention.

The Appellant's citation to various patent references does not overcome the rejection because the mere fact that the other references may or may not identify water as being a moisturizer or part of a moisturizer does not establish that the limitation "moisturizer" in the claims excludes water as being a component of a moisturizer. An applicant may be his own lexicographer, as such, how an applicant chooses to identify a compound need not be the same amongst different applicants. For example, Messenger identifies mineral oil as an emollient (Messenger, Column 4) and McAtee et al. disclose the use of an emollient but does not identify mineral oil as an emollient (McAtee et al., Column 9, lines 60, Column 17, line 64, Column 18, lines 25-31). Further, Lee et al. indicates that optional components include conditioning agents, however, the same does not mean that surface active agents as disclosed in Lee et al. cannot also be conditioning agents (Lee et al., Column 3, lines 41-64, Column 4, line 4). McAtee et al discloses the use of a combination of surfactants as a conditioning agent (McAtee et al., Column 1, lines 62-65, Column 2, lines 1-3). As such, the mere fact that a compound is listed under a

different category does not provide evidence that said category is mutually exclusive of any other characteristic or function of the compound. Similarly, the mere fact that Lee et al. disclose that the composition can optionally include moisturizers does not provide evidence the carrier in Lee et al. does not fall within the scope of the limitation "moisturizer".

It is immaterial that the Appellant is unable to discern a base comprising at least about twenty three percent by weight of a moisturizer from the prior art. The claim is directed to a composition. As such, the claim is directed to a mixture of ingredients. See PIN/NIP Inc. v. Platte Chemical Co., 64 USPQ2d 1344, 1349,1350 (CAFC 2002) (a composition is a mixture of ingredients). As such, claim 1 reads on any mixture of a plurality of abrasive particles having a particle size falling within the range of 50-556 microns and one or more ingredients that can be applied on the skin provided that one or more of the ingredients by weight of said ingredients (not including said abrasive particles) constitute at least about 23% of a moisturizer, regardless of whether the reference cited identifies the one or more ingredients as a base. Further, the base may constitute 100% of a moisturizer. Furthermore, the claimed composition itself actually contains less than about 23% by weight of a moisturizer since the base is mixed with an amount of abrasive particles. As such, in the compositions disclosed in Lee et al., all the ingredients, other than calcite, would fall within the scope of the limitation "base". Since the combination of the other ingredients as a whole would provide moisture to the skin, the combination of other ingredients falls within the scope of the range of at least about 23% by weight of the base of a moisturizer.

The Appellant argues that nowhere within the definition related to lotions and creams cited by the Patent Office is it suggested that water is a moisturizer. However, as indicated

above, a moisturizer is not limited to said definition and the Appellant has admitted that water is moisture. In any case, as indicated above, the limitation "moisturizer" does not exclude water as being a component of a moisturizer. The Appellant indicates that it is well known that water evaporates from the surface of the skin, causing drying of the skin and thus providing the need for a moisturizer. However, it is unclear from said statement whether the Appellant means endogenous water from the skin or water that is topically applied to the skin. In either case, the Appellant has provided no evidence of the same. Further, the Appellant provides no evidence that any standard dictionary would define "moisture" as a state or quality of being damp or that the limitation "moisturizer" would exclude a combination of ingredients that would make the skin damp. However, the issue is not whether the Patent Office would characterize any material falling within this definition as a moisturizer but whether the limitation "moisturizer", which Appellant admits can be a combination of ingredients, excludes water as being one of the ingredients in said combination. As indicated above, the Specification does not require that a moisturizer, in fact, contain either a substance that attracts moisture to the top skin layer or a substance that tends to reduce water loss by creating a barrier. As indicated above, the percent weight of the combination of water, surfactants, and hectorite and/or xanthan gum and NaCl, with or without said other ingredients falls within the scope of the range of at least about 23% by weight of the base of a moisturizer. Since said combination is applied to the skin, said combination would provide moisture to the skin. As such, said combination is a moisturizer. The Appellant has provided no evidence that said combination would not act as moisturizer.

B. Claim 21

With respect to the limitation "where the composition may be left on the skin after application", this is an intended use. In fact, it is by the terms of its language an optional intended use. In any case, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The burden is on the Appellant to show that the prior art composition is not capable of being left on the skin after application.

This has nothing to do with "common knowledge". In an inherency rejection, the Patent Office can require that the Appellant to prove that the prior art products do not inherently possess the characteristics of the claimed invention. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). The Appellant provides no evidence that supports the arguments that the prior art product in Lee et al. cannot be left on the skin after application. Even if the Appellant's arguments were valid, the claims do not indicate any required time limit, minimum or maximum. As such, the act of washing the skin with the product followed by rinsing would meet the limitations of the claim. The Specification supports this conclusion as there is no disclosure in the Specification that specifically indicates that the composition may be left on the skin after application. Paragraph 32 of the Specification indicates that the composition is applied to the skin and the user "wipes off any unabsorbed portion of the composition and may optionally rinse or cleanse the area . . . In one embodiment, the composition . . . may be worked in until

substantially all of the moisturizer (and any other components) is taken up by the skin and only the corundum remains on the surface of the skin. The corundum may be brushed off and the area of the skin cleansed with a mild cleanser". As such, the fact that Lee et al. discloses rinsing the skin after washing the skin with the product does not provide evidence that the composition in Lee et al. may not be left on the skin after application. The examiner is not requiring that the Appellant show that composition of Lee et al. is toxic if left on the skin only that composition in Lee et al. is not capable of being left on the skin after application. The Appellant's attempt to distinguish In re Casey and In re Otto is without merit. The fact that the effect of the composition in Lee et al. if left on the skin may be unknown or that Lee et al. does not itself disclose such a test or the results of such a test does not overcome the rejection. The burden is still on the Appellant to provide evidence that the prior art composition may not be left on the skin after application. See In re Fitzgerald and In re Best cited above.

Claims 1-3,21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saperstein et al. (US Pat. 3,092,111).

A. Claims 1-3, 22,23

For the same reasons as above, contrary to the Appellant's arguments, the limitation "moisturizer" can include a combination of ingredients in which one of the ingredients can be water. As indicated above, claim 2 of the claimed invention indicates that a moisturizer can comprise at least one of a liquid, a gel and an emollient. The Specification further discloses that the moisturizer can include humectants, glycerin, propylene glycol, lanolin, and silicone derivatives, however, as indicated above, a moisturizer is not limited to the same. The base disclosed in Saperstein et al. contains sodium lauryl sulfate, sodium laurate, sodium myristate,

sodium stearate, lanolin, polyethylene glycol, glycerine and water (Saperstein et al., Column 7, lines 6-10). Even without water, the rest of the ingredients add up to 39.4% of the base. A combination containing sodium lauryl sulfate, sodium laurate, myristate sodium stearate, lanolin, polyethylene glycol and glycerine, with or without water, comprises the emollients, lanolin, polyethylene glycol and glycerine. Since a moisturizer can comprises at least one of an emollient and said combination includes the same, said combination constitutes a moisturizer. Further, the Appellant has provided no evidence that the combination of ingredients in the base, with or without water, would not act as a moisturizer. Finally, since water can be included as a component of a moisturizer, the combination of lanolin (0.5%), PEG (10.1%), glycerine (2.8%) and water (60.6%) would also fall within the scope of the claimed limitation. As such, the prior art compositions fall within the scope of the claimed invention.

B. Claim 21

For the same reasons as above, the limitation "where the composition may be left on the skin after application" does not appear to patentably distinguish the invention. Contrary to the Appellant's arguments, Saperstein et al. disclose that the composition can be left on the skin for approximately ten counts (Saperstein et al., Column 8, lines 53-57). The claim does not set forth any minimum time that the composition must be left on the skin, only that the composition may be left on the skin. As such, leaving the composition on the skin for ten counts falls within the scope of the claim limitation. Saperstein et al. does not provide any evidence that the composition may cause damage to the skin if left on the skin. The disclosure cited by the Appellant relates to effects which may occur as a result of scrubbing the skin with the composition when using the composition as intended (Saperstein et al., Column 8, lines 44-68).

There is no indication that if the composition is simply left on the skin that the composition will damage the skin. In any case, as indicated above, the Specification only discloses leaving the composition on the skin in so far as after application the composition is wiped and/or rinsed off. As such, the prior art compositions read on the claimed invention. As indicated above, "Common knowledge" is not at issue and the burden is on the Appellant to show that the prior art compositions are not capable of being left on the skin after application.

Claims 1-3,21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stiefel (US Pat. 4,957,747).

A. Claims 1-3, 22,23

The Appellant argues that Stiefel fails to teach or suggest a composition comprising at least the element of "a base comprising at least about twenty three percent by weight a moisturizer suitable for application to the human skin". As indicated above, the claimed composition actually contains less than about 23% by weight of a moisturizer because the percent weight is based on the weight of the base not the weight of the composition. To further elucidate this premise, claim 7 of Stiefel claims a base in which the components of the base are by weight of the composition. As such, contrary to the claim 1 of the present application, regardless of what amount of aluminum oxide is used in the claimed range of about 35% to about 65% by weight of the composition, the percent weight of emollient in the claimed composition would still be about 5% to about 10%. On the other hand, if one used 65% by weight of the composition of aluminum oxide, in the present claims, the minimum amount of moisturizer in the claimed composition would be about 8.05% by weight of the composition; whereas, if one

used 35% by weight of the composition of the aluminum oxide, the minimum amount of moisturizer in the claimed composition would be about 14.95% by weight of the composition.

For the same reasons as above, contrary to the Appellant's arguments, the limitation "moisturizer" includes a combination of ingredients of which one of the ingredients can be water. As such, all the ingredients in Examples 1 and 2, except for aluminum oxide, would fall within the scope of the limitation "base" (See, for example, claim 7 of Stiefel and discussion of claim 7 above). Claim 2 of the claimed invention indicates that the moisturizer comprises at least one of an liquid, gel and emollient. Examples 1 and 2 of Stiefel include as emollients, polyethylene glycol, glyceryl stearate/PEG 100 stearate, dimethicone and octyl hydroxystearate and as a humectant, glycerine, which in combination with water (32.0158% in Example 1; 24.4052% in Example 2) would add up to a percent weight amount that falls within the scope of the claimed range of at least about 23% by weight of the base (Stiefel, Column 2, lines 15-65). Since said combination comprises emollients and claim 2 of the claimed invention indicates that a moisturizer comprises at least one of an emollient, said combination constitutes a moistuirizer. The Appellant has provided no evidence that the combination would not act as a moisturizer.

B. Claim 21

For the same reasons as above, the limitation "where the composition may be left on the skin after application" does not appear to patentably distinguish the invention. The examiner is not requiring that the Appellant show that the composition in Stiefel is toxic if left on the skin, however, the burden is on Appellant to show that the prior art compositions are not capable of being left on the skin after application. The Appellant argues that the Patent Office has not established its initial burden of showing that this feature is expressly, implicitly or inherently

disclosed. However, in an inherency rejection, if the prior art expressly discloses a composition falling within the scope of the claimed invention, then there is a rebuttable presumption that the prior art composition has the same characteristics as the claimed invention. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). The Appellant has argued in the overview of Stiefel, that Stiefel does not teach that the composition may be left on the skin (Appeal Brief, (3/30/2006), pg. 11). Examples 3 and 4 of Stiefel, however, expressly disclose that the compositions of Examples 1 and 2 were rubbed into the skin of female and male humans (there was no indication that the compositions were subsequently removed) (Stiefel, Columns 3-6). "Common knowledge" is not at issue herein.

Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US 2002/0090385).

The Appellant argues that the 131 affidavit is sufficient to antedate the cited reference. A rule 131 affidavit cannot be used where the US Patent or US Patent Application claims the same invention. See MPEP 715 [R-1]. The term "same invention" includes an obvious variation. Claim 1 recites a crystalline emulsion for use in microdermabrasion comprising crystals coated with methicone and a carrier. Claim 3 which is dependent on claim 3 recites that crystals are selected from the group consisting of magnesium oxide and/or aluminum oxide crystals. Claim 4 recites that the crystals are a particle size of 40-2000 microns. Paragraph 0013 recites that the crystals are preferably about 100-2000 microns. Claim 5 recites that the carrier is selected from the group consisting of a gel, lotion, thick solution, cream, paste or any combination thereof. Claim 6 recites that the coated crystal to carrier ratio is 1 to 2. Paragraph 0025 recites that other

ratios are permissible as indicated above depending on sufficiency of abrasion and emulsion stability. Claim 7 discloses that the emulsion further comprises vitamins C or E or surfactants. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the claims of cited reference by claiming a crystalline emulsion in the form of a cream, having aluminum oxide having a particle size of 40 or 100 microns where the ratio of aluminum oxide to carrier is 50%, and further containing a mineral in the form of magnesium oxide, a vitamin or antioxidant in the form of vitamin C or E and/or an emulsifier in the form of a surfactant, with the expectation that the same would be suitable for use in microdermabrasion of the skin. Claim 5 of the present application is directed to a composition comprising the mixture of a cream and 35% by weight of the composition of corundum particles having an average particle size from 34 to 124 microns. As such, the claims of the cited reference claim the same invention as in claimed invention. Thus, the 131 affidavit is not applicable to antedate the reference. The Appellant's assertion that the Patent Office is comparing the examples in the specification of Fox et al. and not the claims is without merit. Even if Paragraphs 0013 and paragraphs 0025 were not cited, the claims in Fox et al. would still claim the same invention as the claims 5, 7 of the present Application. Claim 4 recite a particle size of 40 microns that is within the claimed range of 34-124 microns and Claim 6 recites a coated crystal to carrier ratio of 1 to 2, i.e. 50%, which is within the range of "at least thirty five percent". Further, for the same reasons as discussed the rejection over Messenger, it is permissible to use the disclosure in the specification of the patent reference to modify the claims of said reference. See e.g. Ex parte Standish, 10 USPQ2d 1454 (BdPatApp&Int 1988).

Contrary to the Appellant's arguments, the affiant in the 131 affidavit, filed on 9/16/2004, states only with respect to the composition referenced as Exhibit A and B of the affidavit that the cream base has moisturizer ingredients that are twenty percent by weight of the base and an aluminum oxide with a particle size of 120 microns (Affidavit (filed 9/16/2004), paragraph 8). The affiant does not identify what ingredients make up the moisturizer much less which ingredients add up to 20% or that the cream base contains at least about 23% of moisturizer ingredients. Further, the affiant does not state that said composition supports the limitation of "at least 35%" of corundum.

The Appellant's argument that the Affidavit shows that there is at least 22.3% of components in the base that can be classified as moisturizers is without merit. In the first case, the affiant never indicated the same or identified what ingredients were moisturizers; as indicated above, said argument contradicts the affiant's sworn statement that the base in the referenced composition contains 20% by weight moisturizers. Also, the base does not actually contain 0.3% panthenol; the base contains 0.3% of 50% panthenol. Further, the Specification does not specifically identify, except for propylene glycol, any of the six ingredients argued by Appellant as adding up to 22.3% as being moisturizers and the Appellant provides no evidence that said ingredients are moisturizers. Furthermore, the composition referenced by the 131 affidavit is different from the example relied upon in paragraph 19 of the Specification to provide support for the claimed invention. The Appellant uses a combination of six, as opposed to three, ingredients to arrive at a amount of 22.3% (actually 22.15% (due to the use of 50% panthenol)) by weight of the base, as opposed to 22.9% by weight of the base (although, as indicated above, this is incorrect as the percent weight of the three ingredients in the example in paragraph 19 of

the Specification is based on the weight of the composition not the weight of the base). As such, the 131 affidavit appears to be directed to subject matter which is wholly outside the claimed invention. See In re Tancyzn, 136 USPQ 298, 301 (CCPA 1965).

A 131 affidavit, in addition to either showing possession of the whole invention or possession of something falling within the claim, in the sense that the claim as a whole reads on it, must show what the reference shows. See In re Tanczyn at 301. The reference disclosure includes the use of 40 microns and 100 microns of aluminum oxide and 50-99% by weight of the aluminum oxide crystals; whereas, the referenced composition only contains 50% by weight of aluminum oxide having a micron size of 120 microns. Claim 7 of the claimed invention further comprises at least one of a mineral. Claim 7 is dependent on claim 5, as such, claim 5 may also include a mineral. The cited reference discloses and claims the use of the mineral, magnesium oxide, in combination with the aluminum oxide crystals to provide microdermabrasion (Fox et al., Paragraphs 0012, claim 3). The referenced base does not disclose the use of magnesium oxide. As such, the 131 affidavit does not show what the reference shows and is not sufficient to antedate the prior art reference.

Claims 1-3,21,22 are rejected under 35 U.S.C. 103(a) as obvious over McAtee et al. (US Pat. 5,607,980).

Contrary to the Appellant's arguments, the Examiner has not admitted that McAtee teaches a composition comprising a moisturizer in an amount lower than that recited in claim. The examiner was simply stating the Appellant's reason for amending the claims (Office Action (12/10/2004, pg. 5). This not an admission that the claimed amount is actually higher the amount disclosed in the prior art.

The Appellant argues that McAtee et al. teaches away from the conclusion reached by the Patent Office because the preferred amounts are less than about 20%. However, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

The Appellant also argues that there is no teaching to include about 23% of the moisturizer in the composition. However, as indicated above, the limitation in the claims is not based on the weight of the composition but on the weight of the base. As such, the composition actually contains less than about 23% by weight of a moisturizer. The amount of about 20% claimed in the reference is based on the weight of the composition (McAtee et al., Column 13, lines 40-63). As indicated above, the reference discloses the use of insoluble aluminum oxide particles. The amount of said particles ranges from about 0.1% to about 20% by weight of the composition (McAtee et al., Column 13, lines 65-68). As such, using the amount of 20% by weight of the composition of said particles, the amount of moisturizer in the claimed composition would be 18.4% by weight of the composition. As such, the percent weight range of the moisturizer disclosed in the prior art reference overlaps the percent weight range by weight of the base of a moisturizer in the claimed invention when converted to an equivalent amount based on the weight of the composition. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16

USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.).

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wdowik (US Pat. 5,756,081).

A. Claims 1,2, 22.

The Appellant argues that the Patent Office has not pointed to a portion of Wdowik expressly teaching a base comprising at least about twenty three percent by weight of a moisturizer suitable for application to the skin. However, as indicated above, notwithstanding the limitation "base", the composition itself is nothing more than a mixture of ingredients. As such, the prior art product contains 97% of a mixture of ingredients that fall within the scope of the limitation "base" and 3% of the particulate having about 75 microns in size which falls within the scope of the abrasive particles ranging from 50-556 microns. Further, as indicated above, the amount of about 23% by weight moisture as claimed is based on the weight of the base not the composition. As such, the claimed composition, if one uses 3% of the abrasive particles, would contain about 22.31 % by weight of the composition of a moisturizer. The combination of lauric acid diethanolamide (1.60%), mineral oil (17%) and glycerine (3.2%) results in an amount of 21.8% of a moisturizer by weight of the composition. The scope of the limitation "about" is not defined by the Appellant. As indicated above, the Appellant has argued that a base allegedly containing 22.3% (actually 22.15%) of a moisturizer provides support in terms of an effective priority date of the range of at least about 23% by weight of the base of a moisturizer. As such, at a minimum, the amount of about 23% must include 22.3% (actually

22.15%). Using the 3% amount of abrasive particles indicated above, the amount of the moisturizer based on the weight of the composition would be 21.63% (actually 21.48%). As such, the Appellant has provided no evidence that the amount of about 23% by weight of the base of a moisturizer excludes 21.8% by weight of the composition of a moisturizer. If one includes the weight of the water, the prior art composition clearly meets the limitations of claim 1. As indicated above, the limitation "moisturizer" cannot be read to exclude water as a component of the moisturizer.

B. Claim 21.

As indicated above, the claim limitation by its own language does not require that the composition be left on the skin after application and constitutes an intended use. Further, the rejection herein is an inherency rejection. As such, since the prior art composition expressly discloses a composition containing the same ingredients as the claimed invention, the burden is on Appellant to show that the prior art composition does not have the same characteristics, i.e. that the prior art composition may not be left on the skin. As indicated above, the limitation does not set any minimum time limit and, thus, the act of applying the composition and shaving is sufficient to meet the limitation "may be left on the skin after application," This interpretation, as indicated above, is supported by the Specification as the Specification does not specifically recite said limitation and discloses that the composition or at least the portion which is not absorbed is wiped and/or rinsed off after application.

Claims 1-3,5,7,21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin (US Pat. 3,852,417) in view of Wdowik (5,756,081).

A. Claims 1-3,22,23

Contrary to the Appellant's arguments, the example in Wdowik indicated above does read on the limitations of claim 1. Further, it is uncertain what the Appellant means by indicating that "we have an expert in the shaving composition field" combining references and producing a result. The basis for an obviousness rejection is what the prior art would have suggested to one of ordinary skill in the art not what examples an inventor chooses to disclose in his patent. As indicated above, disclosed examples and preferred embodiments do not teach away from the broad disclosure. As such, the rejection is not limited to the teachings of the examples. For instance, McLaughlin discloses ranges of amounts for the disclosed ingredients in the examples disclosed in Wdowik, such as, mineral oil (12 to about 25% by weight) (provides lubricating and emollient properties), lauric acid diethanolamide (emollient which provides desired lubricating properties) (about 1-5% by weight), water or aqueous solvent (about 40 to 78%) and glycerine or propylene glycol humectant (up to 8% by weight) (advantageous to include) and Wdowik discloses that the particulate additive can include aluminum oxide, have a particle range of 50-200 microns and be present in an amount of about 20% by weight and higher and the particulate additive is used to provide a nick free shave and scrub the skin thereby improving the smoothness and cleanliness of the skin (McLaughlin, Column 2, lines 18-68, Column 3, Column 4, lines 1-50; Wdowik, Column 3, lines 23-60. Although the Specification does not list lauric acid diethanolamide as having the property of a moisturizer, Claim 2 of the claimed invention claims that the moisturizer in claim 1 comprises at least one of an emollient.

Since lauric acid diethanolamide is disclosed by the prior art to be an emollient, lauric acid diethanolamide reads on the limitation "moisturizer". As such, as indicated above, the combined teachings of the prior art do disclose and suggest the limitations of the claimed invention and one of ordinary skill in the art would have been motivated modify the compositions disclosed in McLaughlin by adding particulate additives for the reasons indicated above and would expect that the shaving creams resulting from the combinations of said ingredients would be effective in softening the skin and leaving the face smooth and in a non-irritated condition (McLaughlin, Column 2, lines 13, 14).

B. Claims 5,7

Contrary to the Appellant's arguments, the disclosure in Wdowik does not establish a clear demarcation between creams and those compositions that might have effective amounts of particulate greater than 20%. The disclosure in Wdowik does not indicate that creams cannot contain more than 20% of the particulate only that thick pastes, solids and gels can contain as high as 90% or higher of the particulate (Wdowik, Column 3, lines 45-53). As indicated above, disclosed examples and preferred embodiments do not constitute a teaching away of the broad disclosure.

C. Claim 21.

For the same reasons as indicated in the rejection over Wdowik above, the limitation "wherein the composition may be left on the skin after application" does not patentably distinguish the claim from the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Johann Richter, Ph. D. Esq.
Supervisory Patent Examiner
Technology Center 1600

Conferees:
Dr. Johann Richter, SPE

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

Ardin Marschel, SPE

Frank Choi
Patent Examiner
TC 1600